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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,917	02/20/2004	Tohru Horio	248233US2	5308
22850 7590 06/25/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER MCCULLOUGH, MICHAEL C				
ART UNIT 3653		PAPER NUMBER		
NOTIFICATION DATE 06/25/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/781,917

Applicant(s)

HORIO, TOHRU

Examiner

MICHAEL C. MCCULLOUGH

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-17, 20-31 and 34-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-17, 20-31 and 34-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The amendment filed 20 March 2009 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-3, 6-17, 20-31, and 33-45 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hidaka et al. (US 2004/0094887 A1).
2. The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 6, 7, 10, 12, 14, 15, 20, 21, 24, 26, 28, 29, 34, 35, 38, 40, 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (US

5,689,793) in view of Sashida (US 6,788,440). Kobayashi et al. discloses an image reading and forming device (10 and see column 3 lines 36-42), a sheet pick-up device (33), a sheet separating device with a rotary member (34), pull-out rollers (43), a drive device (M1 and M2), at least two detecting devices (45 and 47), a first detecting device (38), and a control device (see column 5 line 18). Kobayashi et al. does not disclose the sheet separating device comprises a roller. However, Sashida discloses a similar device that includes a sheet separating device comprises a rotary member (221) and a roller (261) for the purpose of separating and conveying an original or only the uppermost one of a plurality of originals (see column 6 lines 22-29). It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Kobayashi et al. by utilizing a sheet separating device comprises a roller, as disclosed by Sashida, for the purpose of separating and conveying an original or only the uppermost one of a plurality of originals.

4. Claim 2, 16, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (US 5,689,793) in view of Sashida (US 6,788,440), as applied to claims 1, 6, 7, 10, 12, 14, 15, 20, 21, 24, 26, 28, 29, 34, 35, 38, 40, 42 above, in farther view of Jacobson et al. (US 5,924,686). Kobayashi et al. in view of Sashida discloses all of the limitations of the claims but does not disclose the control device measures the drive amount. However, Jacobson et al. discloses a similar device that includes a control device measures the drive amount (see column 7 line 54 through column 8 line 22) for the purpose of feeding a sheet within a certain time period. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to

modify Kobayashi et al. in view of Sashida by utilizing a control device measures the drive amount, as disclosed by Jacobson et al., for the purpose of feeding a sheet within a certain time period.

5. Claim 3, 17, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (US 5,689,793) in view of Sashida (US 6,788,440), as applied to claims 1, 6, 7, 10, 12, 14, 15, 20, 21, 24, 26, 28, 29, 34, 35, 38, 40, 42 above, in farther view of Jacobson et al. (US 5,924,686). Kobayashi et al. in view of Sashida discloses all of the limitations of the claims but does not disclose the control device measures the drive amount. However, Jacobson et al. discloses a similar device that includes a control device measures the drive amount and changes speed based on the drive amount ((see column 7 line 54 through column 8 line 22)) for the purpose of feeding a sheet within a certain time period. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Kobayashi et al. in view of Sashida by utilizing a control device measures the drive amount and changes speed based on the drive amount, as disclosed by Jacobson et al., for the purpose of feeding a sheet within a certain time period.

6. Claims 8, 9, 11, 22, 23, 25, 36, 37, and 39 rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (US 5,689,793) in view of Sashida (US 6,788,440), as applied to claims 1, 6, 7, 10, 12, 14, 15, 20, 21, 24, 26, 28, 29, 34, 35, 38, 40, 42 above, in farther view of Jacobson et al. (US 5,924,686). Kobayashi et al. in view of Sashida discloses all of the limitations of the claims but does not disclose a display device. However, Jacobson et al. discloses a similar device that includes a

display device (see column 9 lines 52-57) for the purpose of displaying if a threshold is exceeded. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Kobayashi et al. in view of Sashida by utilizing a display device, as disclosed by Jacobson et al., for the purpose of displaying if a threshold is exceeded.

7. Claim 13, 27, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (US 5,689,793) in view of Sashida (US 6,788,440), as applied to claims 1, 6, 7, 10, 12, 14, 15, 20, 21, 24, 26, 28, 29, 34, 35, 38, 40, 42 above, in farther view of Hamamoto et al. (US 6,421,581 B1). Kobayashi et al. in view of Sashida discloses all of the limitations of the claims but does not disclose a pulse motor. However, Hamamoto et al. discloses a similar device that includes a pulse motor (34) for the purpose of controlling the feeding of a sheet (see column 6 lines 13-35). It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Kobayashi et al. in view of Sashida by utilizing a pulse motor, as disclosed by Hamamoto et al., for the purpose of controlling feeding of a sheet.

8. Claims 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (US 5,689,793) in view of Sashida (US 6,788,440). Kobayashi et al. discloses means for reading and means for forming an image (10 and column 3 lines 36-42), a sheet feeding device comprising means for picking (33), means for separating comprising means for feeding (34), pull-out rollers (43), means for driving (M1 and M2), at least first and second means for detecting (45 and 47), and means for controlling (see column 5 line 18). Kobayashi et al. does not disclose the means for separating

comprises means for obstructing. However, Sashida discloses a similar device that includes separating comprises means for feeding (221) and means for obstructing (261) for the purpose of separating and conveying an original or only the uppermost one of a plurality of originals (see column 6 lines 22-29). It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Kobayashi et al. by utilizing means for separating comprises means for obstructing, as disclosed by Sashida, for the purpose of separating and conveying an original or only the uppermost one of a plurality of originals.

Response to Arguments

9. Applicant's arguments with respect to claims 1-3, 6-17, 20-31, 34-45 have been considered but are moot in view of the new ground(s) of rejection.
10. Claims 2, 6-9, 16, 20-23, 30, and 34-37 recite conditional limitations that need not occur and as long as all of the conditions are not claimed the conditional limitations do not distinguish over the prior art. The words "if" and "when" are conditional, "in accordance with" or "upon" are not conditional.
11. Claims 1-45 contain limitations of "configured" which does not positively recite the action. See MPEP 2106.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL C. MCCULLOUGH whose telephone number is (571)272-7805. The examiner can normally be reached on Monday-Friday, 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick H. Mackey/
Supervisory Patent Examiner, Art
Unit 3653

MCM